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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,743	10/27/2000	Kevin Bowen	99-26	6821

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EXAMINER

DAWSON, GLENN K

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,743

Applicant(s)

BOWEN ET AL.

Examiner

Glenn K Dawson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23,24,26,29,30,41-44 and 46-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23,24,26 and 50 is/are allowed.
- 6) ☒ Claim(s) 29,30,41-44 and 46-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07-30-2004</u> | 6) <input type="checkbox"/> Other: _____ |

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification does not provide antecedent basis for the controller ceasing communication with the storage device when the storage device is disposed a predetermined distance from the transceiver.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 43 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new limitation in the last 4 lines of claim 43 constitutes new matter in that the original specification does not support the ceasing of communication between the controller and the storage device when the storage device is a distance from the transceiver.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29,30,41,42,44,46 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 29, there is no antecedent basis for "the pressure support device".

In claim 41, there is no antecedent basis for "the information storage device" and "the pressure support device".

In claim 42, it is unclear if the external device is disposed "in" or "on" the receiving means.

The preambles of claim 44 and 46 are unclear; "configuring and pressure support system" is vague and unclear.

In claim 46, there is no antecedent basis for "the medical device".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 43 is rejected under 35 U.S.C. 102(e) as being anticipated by Aylsworth, et al.-5890490.

Aylsworth discloses a pressure generating system for delivering breathing gas to a patient, a controller that can be preprogrammed with a patient's prescriptions to deliver gas to the patient according to the specifications of a health care practitioner. Data can be sent back and forth from the control module via modem. Once the storage device is removed from the reader slot (it would then be at a distance) from the transceiver) the communication link would be broken. See col. 5 lines 12-16 and 40-54; col. 7 lines 27-29 and 61-65; col. 10 lines 59-67; col. 11 lines 1-3 and 39-41; col. 12 lines 14-18.

Claim 48 is rejected under 35 U.S.C. 102(b) as being anticipated by Willemot, et al.-5560353.

Willemot discloses a programmable card having instructions which could be downloaded to, or uploaded from a control center. The card would inherently have areas in its memory which could contain any type of data. The claims are merely limited to the card being capable of having the claimed data thereon, not that the card actually has the claimed data. The examiner contends that the card of Willemot could be programmed to have the claimed data thereon.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 44, 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willemot, et al.-'353 in view of applicant's own disclosure.

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Willemot discloses a pressure support device having a slot for receiving a memory card and patient and operating information encoded thereon. A readout displays the number of doses of medication received. Information is written from the device to the card which is then taken to a reading station to be reviewed by a healthcare practitioner. Willemot also discloses that the device could be used to control CPAP see col. 3 lines 47-59

The applicant's own specification states that it was known that conventional ventilators are capable of operating in different ventilation modes and that it was common to select from a variety of modes using devices on the ventilator. Physically setting the modes required authorized personnel. It was also disclosed that it was appreciated that it might be necessary to change to different modes of operation over the course of a treatment regimen.

Therefore, the examiner contends that it would have been obvious to have modified the prior art disclosed by the applicant with the teachings of Willemot, as it would allow for a more efficient manner in which to remotely program and actuate the mechanics of a ventilator and allow it to change modes of operation and parameters, which are needed at times as noted by the applicant, and would prevent the need for more than one ventilator to be used per patient and would not necessitate the need for an authorized person to perform a change in mode of operation at the actual site of use.

Since Willemot clearly discloses the use of a card and reader to remotely program and use a CPAP device, it would have been obvious, in the event that the patient using the ventilator needed to have the ventilator change modes of operation (as

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noted by the applicant) to have the card programmed with info. to control the ventilator to change to a different mode and to change its operating parameters, so as to provide an efficient manner in which to remotely provide the ventilator with the proper instructions to carry out the intended patient protocol or regimen.

Allowable Subject Matter

Claims 23,24,26 and 50 are allowed.

Claims 29 and 30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 41,42 and 46 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K Dawson whose telephone number is 703-308-4304. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 703-308-2154. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Glenn K Dawson
Primary Examiner
Art Unit 3731

Gkd
25 October 2004